

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Our Case No. 14829US02)

In the Matter of:)	
)	<i>Electronically Filed on June 19, 2009</i>
Jeyhan Karaoguz, et al.)	
)	
Serial No. 10/672,907)	
)	
Filed: September 26, 2003)	
)	
For: THEFT PREVENTION OF)	
MEDIA PERIPHERALS IN A MEDIA)	
EXCHANGE NETWORK)	
)	
Examiner: Christopher A. Revak)	
)	
Group Art Unit: 2431)	
)	
Confirmation No. 9187)	

APPEAL BRIEF

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Applicants respectfully request that the Board of Patent Appeals and Interferences reverse the final rejection of claims 1-25 of the present application. The Applicants request a 1-month extension of time in which to respond. Thus, the period for response runs until July 11, 2009 (2 months after the May 11, 2009 mailing date of the Notice of Panel Decision from Pre-Appeal Brief Review).

REAL PARTY IN INTEREST
(37 C.F.R. § 41.37(c)(1)(i))

The real party in interest is Broadcom Corporation, having a place of business at 16215 Alton Parkway, Irvine, California.

RELATED APPEALS AND INTERFERENCES
(37 C.F.R. § 41.37(c)(1)(ii))

Not applicable.

STATUS OF THE CLAIMS
(37 C.F.R. § 41.37(c)(1)(iii))

The present application includes claims 1-25, all of which stand rejected.¹ The Applicants identify claims 1-25 as the claims that are being appealed. The text of the claims involved in this Appeal is provided in the Claims Appendix.

STATUS OF AMENDMENTS
(37 C.F.R. § 41.37(c)(1)(iv))

Subsequent to the final rejection of claims 1-25 mailed December 3, 2008, the Applicants filed a Response.² However, this Response did not amend any of the pending claims.³

¹ See December 3, 2008 Final Office Action, February 25, 2009 Advisory Action and May 11, 2009 Notice of Panel Decision from Pre-Appeal Brief Review.

² See February 5, 2009 Response Under 37 C.F.R. § 1.116.

³ See *id.*

SUMMARY OF CLAIMED SUBJECT MATTER
(37 C.F.R. § 41.37(c)(1)(v))

Independent claim 1 recites the following:

A method of theft prevention of communication devices used in a communication network,⁴ the method comprising:

registering a communication device deployed at a location that is communicatively coupled to the communication network,⁵ wherein said registering uses at least one registration information associated with said location,⁶ wherein said at least one registration information comprises a device serial ID number associated with said location where the communication device is registered;⁷

receiving validation information relating to the communication device, the validation information entered via the communication device;⁸ and

determining whether the communication device is authorized for use in the communication network, based on at least the validation information entered via the communication device.⁹

Independent claim 7 recites the following:

A system supporting theft prevention of communication devices used in a communication network,¹⁰ comprising:

at least one processor, communicatively coupled to the communication network,¹¹ that receives registration information related to a communication device,¹² said registration information associated with at least a location of the communication

⁴ See present application, e.g., at page 4, lines 2-10, page 8, lines 2-17, Figure 1, ref. 100.

⁵ See *id.*, e.g., at page 4, lines 5-6.

⁶ See *id.*, e.g., at page 12, line 16 to page 14, line 15.

⁷ See *id.*, e.g., at page 12, line 16 to page 14, line 15.

⁸ See *id.*, e.g., at page 4, lines 6-8.

⁹ See *id.*, e.g., at page 4, lines 8-10.

¹⁰ See *id.*, e.g., at page 4, lines 11-13, page 8, lines 2-17, Figure 1, ref. 100.

¹¹ See *id.*, e.g., at page 4, lines 13-14.

¹² See *id.*, e.g., at page 4, lines 14-15.

device,¹³ wherein said registration information comprises a device serial ID number of the communication device associated with said location where the communication device is registered,¹⁴ the at least one processor further receives validation information entered into the communication network via the communication device,¹⁵ and determines whether the communication device is authorized for use in the communication network, based on the received validation information.¹⁶

Independent claim 9 recites the following:

A system supporting theft prevention of communication devices used in a communication network,¹⁷ comprising:

a communication device deployed in a home environment;¹⁸ and

a communication network communicatively coupled to the home environment,¹⁹ the communication network receiving registration information for the communication device,²⁰ the registration information associated with a location of the communication device, wherein said registration information comprises a device serial ID number of the communication device associated with said location,²¹ the communication network receiving validation information entered via the communication device and relating to the communication device, and determining whether to grant the communication device access to the communication network, based on the validation information entered via the communication device.²²

¹³ See *id.*, e.g., at page 12, line 16 to page 14, line 15.

¹⁴ See *id.*, e.g., at page 12, line 16 to page 14, line 15.

¹⁵ See *id.*, e.g., at page 4, lines 15-16.

¹⁶ See *id.*, e.g., at page 4, lines 16-18.

¹⁷ See *id.*, e.g., at page 4, lines 19-25, page 8, lines 2-17, Figure 1, ref. 100.

¹⁸ See *id.*, e.g., at page 4, lines 21-22.

¹⁹ See *id.*, e.g., at page 4, line 22.

²⁰ See *id.*, e.g., at page 12, line 16 to page 14, line 15.

²¹ See *id.*, e.g., at page 12, line 16 to page 14, line 15.

²² See *id.*, e.g., at page 4, lines 22-25.

Independent claim 15 recites the following:

A system supporting theft prevention of communication devices used in a communication network,²³ comprising:

a storage device²⁴ residing in a first home²⁵ environment;²⁶

a media device residing in a second home²⁷ environment;²⁸ and

a communication network communicatively coupled to the first home environment and the second home environment,²⁹ the communication network receiving registration information for the media device,³⁰ the registration information associated with at least the second home environment, wherein the registration information comprises a device serial ID number of the media device associated with the second home environment,³¹ the communication network analyzing validation information entered via the media device, and determining whether to grant access to the media device to the first home environment via the communication network, based on the validation information entered via the media device residing in the second home environment.³²

Dependent claim 22 recites the following:³³

The method of claim 1, wherein said registering comprises entering the device serial ID number of the communication device associated with said location where the communication device is registered if the device is to be used only at said location

²³ See *id.*, e.g., at page 4, line 26 to page 5, line 4, page 8, lines 2-17, Figure 1, ref. 100.

²⁴ See *id.*, e.g., at page 10, lines 10-14.

²⁵ See *id.*, e.g., at page 8, lines 4-7, Figure 1, ref. 104

²⁶ See *id.*, e.g., at page 4, line 28 to page 5, line 1.

²⁷ See *id.*, e.g., at page 8, lines 4-7, Figure 1, ref. 108.

²⁸ See *id.*, e.g., at page 5, line 1.

²⁹ See *id.*, e.g., at page 5, lines 1-2.

³⁰ See *id.*, e.g., at page 12, line 16 to page 14, line 15.

³¹ See *id.*, e.g., at page 12, line 16 to page 14, line 15.

³² See *id.*, e.g., at page 5, lines 2-4.

³³ Note, dependent claims 23-25 recite similar limitations.

where the communication device is registered,³⁴ and wherein said registering comprises entering the device serial ID number of the communication device, a user name and a password if the communication device is to be used at another location that is separate and distinct from said location wherein the communication device is registered.³⁵

GROUND OF REJECTION TO BE REVIEWED ON APPEAL
(37 C.F.R. § 41.37(c)(1)(vi))

- Claims 1-4 and 7-25 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 6,643,781 ("Merriam") in view of U.S. 7,133,920 ("Tsujiisawa") and U.S. 7,317,798 ("Saito").
- Claims 5 and 6 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Merriam in view of Tsujiisawa, Saito and U.S. 5,748,084 ("Isikoff").

ARGUMENT
(37 C.F.R. § 41.37(c)(1)(vii))

As shown above, the proposed combination of Merriam, Tsujiisawa and Saito forms the basis for all the claim rejections. However, as detailed below, this combination of references does not describe, teach or suggest registration information that includes a "device serial ID number associated with [a] location where [a] communication device is registered," as recited in claim 1, for example.

³⁴ See *id.*, e.g., at page 12, lines 25-27.

I. The Proposed Combination Of Merriam In View Of Tsujisawa And Saito Does Not Render Claims 1-4 And 7-25 Unpatentable

Claims 1-4 and 7-25 stand rejected as being unpatentable over Merriam in view of Tsujisawa and Saito. In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure ("MPEP") states the following:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."

See the MPEP at § 2142, citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), and *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval).

Additionally, if a *prima facie* case of obviousness is not established, the Applicants are under no obligation to submit evidence of nonobviousness:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

"To establish *prima facie* obviousness of a claimed invention, **all the claim limitations** must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." See MPEP at 2143.03 (emphasis added). Further, "[a]ll words in a claim must be considered in judging the patentability of that claim

³⁵ See *id.*, e.g., at page 12, line 27 to page 13, line 2.

against the prior art.’ *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA).”
See id. (emphasis added).

A. The Proposed Combination Does Not Render Claim 1 And The Claims That Depend Therefrom Unpatentable

With those principles in mind, claim 1 of the present application recites, in part, “wherein said at least one registration information comprises a device serial ID number associated with said location where the communication device is registered.” The claim clearly recites that the device serial number is associated **with a location where the communication device is registered**.

The Office Action acknowledges that the “combined teachings of Merriam and Tsujisawa fail to disclose of registration information associated with a device serial ID number associated where the location [of] the communication device is registered.” See December 3, 2008 Office Action at page 3.

In an attempt to overcome this deficiency, the Office Action cites Saito. *See id.* In particular, the Office Action relies on Saito at column 14, lines 49-67.

Saito discloses that the “device ID of the mobile terminal corresponding to the acquired home address is registered in the database 114.” See Saito at column 14, lines 52-54. While Saito discloses that the device ID is registered in the database, there is nothing in the portion of Saito relied on by the Office Action, nor the remainder of Saito, that describes, teaches or suggests that the device ID is associated **with a location where the mobile terminal itself is registered**. Again, Saito merely discloses that the device ID is registered in a database.

The Advisory Action states that “Saito discloses of acquiring a home address as an IP address of a corresponding terminal and it is checked to see whether the acquired home address is registered in the database, see column 14, lines 49-53.” See February 25, 2009 Advisory Action at page 2. However, this portion of Saito discloses the following:

If the server 107 acquires the home address, as the IP address, of the responding terminal 102 from the DNS (Domain Name Server) 123, the server 107 checks whether the device ID of the mobile terminal corresponding to the acquired home address is registered in the database 114 (FIG. 17).

See Saito at column 14, lines 49-54. As shown above, this cited portion of Saito merely indicates that the server determines whether the device ID of the mobile terminal is registered in the database. Neither it, nor the remainder of Saito describes, teaches or suggests, however, that the device ID is associated with the location where the mobile terminal itself is registered. Again, this portion merely indicates that the device ID is registered.

None of Saito, Merriam or Tsujisawa describes, teaches or suggests “wherein said at least one registration information comprises a **device serial ID number associated with said location where the communication device is registered**,” as recited in claim 1. Thus, for at least these reasons, the Applicants respectfully submit that the proposed combination of Merriam, Tsujisawa and Saito does not render claims 1-4 unpatentable.

B. The Proposed Combination Does Not Render Claim 7 And The Claims That Depend Therefrom Unpatentable

As explained above, the proposed combination of references does not describe, teach or suggest “a device serial ID number of the communication device **associated with said location where the communication device is registered**,” as recited in claim 7. Thus, for at least these reasons, the proposed combination does not render claim 7 and the claims that depend therefrom unpatentable.

C. The Proposed Combination Does Not Render Claim 9 And The Claims That Depend Therefrom Unpatentable

As explained above, the proposed combination of references does not describe, teach or suggest “the registration information associated with a location of the communication device, wherein said registration information comprises a device serial

ID number of the communication device associated with said location,” as recited in claim 9. Thus, for at least these reasons, the proposed combination does not render claim 9 and the claims that depend therefrom unpatentable.

D. The Proposed Combination Does Not Render Claim 15 And The Claims That Depend Therefrom Unpatentable

As explained above, the proposed combination of references does not describe, teach or suggest “the registration information associated with at least the second home environment, wherein the registration information comprises a device serial ID number of the media device associated with the second home environment,” as recited in claim 15. Thus, for at least these reasons, the proposed combination of references does not render claim 15 and the claims that depend therefrom unpatentable.

E. The Proposed Combination Does Not Render Claims 22-25 Unpatentable For Additional Reasons

Additionally, claim 22 recites “wherein said registering comprises entering the device serial ID number of the communication device associated with said location where the communication device is registered **if the device is to be used only at said location where the communication device is registered**, and wherein said registering comprises entering the device serial ID number of the communication device, a user name and a password **if the communication device is to be used at another location that is separate and distinct from said location wherein the communication device is registered.**” Claims 23-25 recite similar limitations.

The Office Action relies on Saito at column 14, lines 49-67 as disclosing the limitations regarding the device ID. See December 3, 2008 Office Action at page 10.

However, Saito merely discloses that a device ID is registered in a database. There is nothing in the cited references, however, that describes, teaches or suggests “entering the device serial ID number of the communication device associated with said location **where the communication device is registered** if the device is to be used **only at said location where the communication device is registered**, and

wherein said registering comprises **entering the device serial ID number of the communication device, a user name and a password** if the communication device is to be used at another location that is separate and distinct from said location wherein the communication device is registered.” Indeed, there is nothing in the portion of Saito relied on by the Office Action (nor the remainder of Saito) that even describes, teaches or suggests entering a device serial ID number of a communication device **in order to use the communication device**.

The Advisory Action indicates, however, that the “applicant argues that nothing in the cited reference disclose of ‘entering the device serial ID.’” See February 25, 2009 Advisory Action at page 2. As shown above, however, the Applicants are not merely arguing that the proposed combination does not describe, teach or suggest “entering the device serial ID,” as suggested in the Advisory Action. Rather, the Applicants maintain that the Office Action has not demonstrated that any of the cited references describes, teaches or suggests the limitations of claims 22-25 or even entering a device serial ID number of a communication device **in order to use the communication device**. Instead, the Office Action and Advisory Action merely indicate portions of Saito that discloses that a device is “registered.”

Thus, for at least these additional reasons, the proposed combination of references does not render claims 22-25 unpatentable.

II. The Proposed Combination Does Not Render Claims 5 And 6 Unpatentable

The Applicants also respectfully submit that the proposed combination of Merriam, Tsujisawa, Saito and Isikoff does not render claims 5 and 6 unpatentable for at least the reasons discussed above with respect to claim 1.

III. CONCLUSION

For at least the reasons discussed above, the Applicants respectfully submit that the pending claims are in condition for allowance. Therefore, the Board is respectfully requested to reverse the rejections of pending claims 1-25.

IV. PAYMENT OF FEES

The Commissioner is authorized to charge any necessary fees, including the \$540 fee for this Appeal Brief and the \$130 fee for the 1-month extension, or credit overpayment to Deposit Account 13-0017.

Respectfully submitted,

Dated: June 19, 2009

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CLAIMS APPENDIX
(37 C.F.R. § 41.37(c)(1)(viii))

1. A method of theft prevention of communication devices used in a communication network, the method comprising:

registering a communication device deployed at a location that is communicatively coupled to the communication network, wherein said registering uses at least one registration information associated with said location, wherein said at least one registration information comprises a device serial ID number associated with said location where the communication device is registered;

receiving validation information relating to the communication device, the validation information entered via the communication device; and

determining whether the communication device is authorized for use in the communication network, based on at least the validation information entered via the communication device.

2. The method of claim 1, wherein registering the communication device comprises one or more of recognizing a digital certificate stored in the communication device, entering roaming preferences for the communication device, and/or entering a password.

3. The method of claim 1, wherein receiving of the validation information comprises one or more of receiving the device serial ID number, recognizing a digital certificate stored in the communication device, and/or receiving a password.

4. The method of claim 1, comprising:

locking the communication device out of the communication network upon determination that the communication device is unauthorized.

5. The method of claim 4, comprising:

determining the location of the communication device.

6. The method of claim 5, comprising:

notifying an authority of the location of the communication device, if the communication device has been reported as stolen.

7. A system supporting theft prevention of communication devices used in a communication network, comprising:

at least one processor, communicatively coupled to the communication network, that receives registration information related to a communication device, said registration information associated with at least a location of the communication device, wherein said registration information comprises a device serial ID number of the communication device associated with said location where the communication device is registered, the at least one processor further receives validation information entered into the communication network via the communication device, and determines whether the communication device is authorized for use in the communication network, based on the received validation information.

8. The system of claim 7, wherein the at least one processor comprises one or both of a personal computer and/or a set-top-box.

9. A system supporting theft prevention of communication devices used in a communication network, comprising:

a communication device deployed in a home environment; and

a communication network communicatively coupled to the home environment, the communication network receiving registration information for the communication device, the registration information associated with a location of the communication device, wherein said registration information comprises a device serial ID number of the communication device associated with said location, the communication network receiving validation information entered via the communication device and relating to the communication device, and determining whether to grant the communication device access to the communication network, based on the validation information entered via the communication device.

10. The system of claim 9, wherein the communication network comprises one or more of a third party media server, a media storage server, a broadband access headend, a cable infrastructure, a satellite network infrastructure, a digital subscriber line (DSL) infrastructure, an Internet infrastructure, an intranet infrastructure, a wired infrastructure, a closed communication infrastructure, and/or a wireless infrastructure.

11. The system of claim 10, wherein the communication network comprises the Internet.

12. The system of claim 10, wherein the communication network comprises the closed communication infrastructure.

13. The system of claim 9, wherein the authorization information comprises one or more of the device serial ID number, a digital certificate, and/or a password.

14. The system of claim 9, wherein the communication device comprises one or more of a digital camera, a digital camcorder, a television, a personal computer, a CD player, a juke-box, a multi-media gateway device, a multi-media personal digital assistant, a DVD player, a tape player, a media player, and/or a MP3 player.

15. A system supporting theft prevention of communication devices used in a communication network, comprising:

- a storage device residing in a first home environment;

- a media device residing in a second home environment; and

- a communication network communicatively coupled to the first home environment and the second home environment, the communication network receiving registration information for the media device, the registration information associated with at least the second home environment, wherein the registration information comprises a device serial ID number of the media device associated with the second home environment, the communication network analyzing validation information entered via the media device, and determining whether to grant access to the media device to the first home environment via the communication network, based on the validation information entered via the media device residing in the second home environment.

16. The system of claim 15, wherein the communication network analyzes authorization information and determines whether to grant access of the media device to the storage device.

17. The system of claim 15, wherein the communication network comprises one or more of a third party media server, a media storage server, a broadband access headend, a cable infrastructure, a satellite network infrastructure, a digital subscriber line (DSL) infrastructure, an Internet infrastructure, an intranet infrastructure, a wired infrastructure, a closed communication infrastructure, and/or a wireless infrastructure.

18. The system of claim 17, wherein the communication network comprises the Internet.

19. The system of claim 17, wherein the communication network comprises the closed communication infrastructure.

20. The system of claim 15, wherein the authorization information comprises one or more of the device serial ID number, a digital certificate, and/or a password.

21. The system of claim 15, wherein the media device comprises one or more of a digital camera, a digital camcorder, a television, a personal computer, a CD player, a juke-box, a multi-media gateway device, a multi-media personal digital assistant, a DVD player, a tape player, a media player, and/or a MP3 player.

22. The method of claim 1, wherein said registering comprises entering the device serial ID number of the communication device associated with said location where the communication device is registered if the device is to be used only at said location where the communication device is registered, and wherein said registering comprises entering the device serial ID number of the communication device, a user name and a

password if the communication device is to be used at another location that is separate and distinct from said location wherein the communication device is registered.

23. The system of claim 7, wherein said registration information comprises the device serial ID number of the communication device associated with said location where the communication device is registered if the device is to be used only at said location where the communication device is registered, and wherein said registration information comprises the device serial ID number of the communication device, a user name and a password if the communication device is to be used at another location that is separate and distinct from said location where the communication device is registered.

24. The system of claim 9, wherein said registration information comprises the device serial ID number of the communication device associated with said location where the communication device is registered if the device is to be used only at said location where the communication device is registered, and wherein said registration information comprises the device serial ID number of the communication device, a user name and a password if the communication device is to be used at another location that is separate and distinct from said location where the communication device is registered.

25. The system of claim 15, wherein the registration information comprises the device serial ID number of the media device associated with the second home environment if the media device is to be used only at the second home environment, and wherein the registration information comprises the device serial ID number of the media device, a user name and a password if the media device is to be used at another location that is separate and distinct from the second home environment.

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EVIDENCE APPENDIX
(37 C.F.R. § 41.37(c)(1)(ix))

- (1) U.S. 6,643,781 ("Merriam"), entered into record by June 14, 2007 Office Action.
- (2) U.S. 7,133,920 ("Tsujiisawa"), entered into record by May 13, 2008 Office Action.
- (3) 7,317,798 ("Saito"), entered into record by December 3, 2008 Office Action.
- (4) U.S. 5,748,084 ("Isikoff"), entered into record by August 4, 2005 Office Action.

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RELATED PROCEEDINGS APPENDIX
(37 C.F.R. § 41.37(c)(1)(x))

Not applicable.